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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,717	10/23/2001	Richard J. Knapp	97634.00089	3818
72535 7590 02/05/2009 MCCARTER & ENGLISH, LLP STAMFORD OFFICE FINANCIAL CENTRE, SUITE 304A 695 EAST MAIN STREET STAMFORD, CT 06901-2138			EXAMINER NGUYEN, TAN D	
			ART UNIT 3689	PAPER NUMBER
			MAIL DATE 02/05/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/047,717		KNAPP, RICHARD J.	
	Examiner		Art Unit	
	Tan Dean D. Nguyen		3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,6-9,12,13,21 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,6-9,12,13,21 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/6/2008 has been entered.

Response to Amendment

2. The amendment of 11/6/08 has been entered. Claims 3-4, 6-9, 12-13, 21, 25-26, 27-28 are pending. They comprise:

- 1) system: 25, 3-4, 6-9, and 12-13 and
- 2) method: 26, 21, 27-28.

Method claims 26, 21 and 27-28 appear to be broader and will be examined first.

Claim Rejections - 35 USC § 112

1. Claims 26, 21 and 27-28, and 25, 3-4, 6-9, and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In independent method claim 26, step (e), the phrase "uploading the nested e-palette to a server" is vague because it's not clear whether this is a new/different server or the server of the previous step (a)?

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2) In claim 26, it's not clear the relationship of the last 2 steps (i) and (j)? What do you do with the result of the compared step/result?

3) It's not clear whether the last step (j) fulfills the scope of the claimed invention which is "facilitation communication between specifiers and suppliers".

3) Similarly, independent system claim 25, which appears to have similar limitations to claim 26 above, is rejected for the same reasons set forth in the rejection of claim 26 above.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims 26, 21, 27-28 (method) and 25, 3-4, 6-9, and 12-13 (system) are rejected under 35 U.S.C. 103(a) as obvious over BADE ET AL in view of YON et al or vice versa.

As of 11/16/2008, independent method claim 26 is as followed:

26 (New) A method for facilitating communications between specifiers and suppliers using a server-based system, the method comprising the steps of:

a. providing a server-based system including a server, one or more specifier workstations in communication with the server, and one or more supplier workstations in communication with the server;

b. using one of the specifier workstations to predefine a plurality of specifier shades, a plurality of specifier substrates and a plurality of suppliers, wherein each specifier shade is characterized by a set of spectral data and wherein the predefined pluralities of specifier shades, specifier substrates and suppliers are stored in a specifier database;

c. using the one of the specifier workstations to create a nested e-palette for a set of goods by selecting from the specifier database (1) a set of one or more of the plurality of specifier substrates for association with the set of goods and (2) a set one or more of the plurality of specifier shades for association with each selected specifier substrate, wherein each selected specifier substrate and each selected specifier shade defines a nesting within the nested e-palette;

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d. using the one of the specifier workstations to select from the specifier database a predetermined set of one or more of the plurality of suppliers for association with one or more of the nestings within the nested e-palette;

e. uploading the nested e-palette to a server, whereby the server automatically communicates the existence of the uploaded nested e-palette to the predetermined set of suppliers associated with the nestings within the nested e-palette;

f. restricting access to at least one of: (1) the uploaded nested e-palette and (2) one or more of the nestings within the uploaded nested e-palette, based upon the predetermined sets of suppliers associated with the nestings within the uploaded nested e-palette;

g. using one of the specifier workstations to remotely access the uploaded nested e-palette;

h. providing the one of the specifier workstations with submission data for one or more supplier shades associated with one or more supplier substrates, the submission data including sets of actual spectral data from one or more test samples;

i. using the one of the specifier workstations to compare the sets of actual spectral data to the sets of spectral data associated with the uploaded nested e-palette; and

j. uploading the submission data to the server for specifier review.

5. Note: In claim 1, step (b), the phrase "...to predefine a plurality ofspecifier database" is not a positively recited method step but, rather, is mere intended use of

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the used workstation and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps.

Similarly, these phrase “to” in steps (c), (d), (g) and (i) are interpreted for the same reasons set forth above and therefore having no patentable weight in a method claims.

As for independent method claim 26, Similarly, **BADE et al** discloses a method for facilitating communications (or “...**collaborative** *method of designing systems ...*” {see par. 0022"}) between plurality of entities, 1st entity functions as a specifier and a 2nd plurality of entities function as plurality of suppliers, said method comprising:

a) receiving information from an order across a computer network at a server, the information originating from a 1st entity (specifier) workstation and including information about the project/design project, said information associated with the project defined by the 1st entity (specifier), the information associated with the project/design including a set of goods (product) and a predetermined set of suppliers;

{see Figs. 2, 41, paragraphs [0009], [0023], [0108], [0111], and [0207]}

b) automatically communicating to said predetermined set of suppliers the existence of said project/project design at said server; and

{see paragraphs [0207]-[0208], Figs. 8 and 44}

c) permitting remote access to said project/project design by said predetermined set of suppliers at said server.

{see [0023 "...a vendor to access a design published by a designer on the bidding board... vendor may receive a request for quote that includes access privilege to the design..."], [0207]}.

BADE et al fairly teaches the claimed invention except for the features of the information in the order/quote received contains specified color data spectra or e-palette information and information associated with the specified e-palette.

Similarly, **YON et al** discloses a method for facilitating communications between 2 entities, first entity serving as a specifier and a 2nd entity serving as one or more suppliers, said method comprising:

a) receiving an order in the form of electronic (web) template/page or palette across a computer network at a server, said template/page (palette) originating from a specifier (customer or purchaser) workstation and including parameters related to said template/palette, said parameters including a set of goods (product) and a predetermined set of suppliers associated with said template/palette by said specifier (customer/purchaser);

{see Figs. 1, 2, elements 32, 34, 36, 44, Fig. 4, elements 52, Fig. 6, 60, cols. 3, lines 5-65, col. 4, lines 5-40, col. 7, lines 1-65}

b) automatically communicating to said predetermined set of suppliers the existence of said template/web page (palette) at said server; and

{see Fig. 1, col. 3, lines 4-45, col. 7, lines 1-60}

c) permitting remote access to said template/palette by said predetermined set of suppliers at said server.

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{see col. 3, lines 4-40, col. 7, lines 1-12, col. 8, lines 4-45}.

Note, as for the term “e-palette” which appears to be similar to electronic template or page or web page, this is taught in YON et al on cols. 3-4, Figs. 2-5. Note that on col. 4, lines 15-20, YON et al discloses the field (44) on Fig. 2 as “color palette field”. Therefore, the teaching of Fig. 2 reads over “e-palette”. Alternative, since the palettes of Fig. 2 and col. 4, lines 1-25 are transferred via electronically (via the Internet), it would have been obvious to change the name of web page or template in YON et al to e-palette if desired to indicate that the palette is carried out electronically.

It would have been obvious to modify the order information about the design project of **BADE et al** to include specified color data spectra or e-palette information and information associated with the specified e-palette as taught by YON et al if the design item requires color feature or desired color as taught by YON et al {see cols. 1-2, Figs. 2-6.

Alternatively, YON et al fairly teaches the claimed invention except for a plurality of suppliers in the preamble and the access to the order information. It would have been obvious to modify the teachings by including the two features above as taught by BADE et al to allow effective or better bidding when multiple vendors or suppliers are involved and are competed against each other to inherently provide good service at lower cost.

6. As for dep. claim 21 (part of 26 above), which deal with well known color spectra data or e-palettes parameters and order parameters, these are well known and are taught in cols. 3-5 or 7 or Figs. 2, 4 and 6 of YON et al. Note also, that these are further

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limitation or functions on the information/data received in step (c) and stored in the database, they are considered as non-functional descriptive material (NFDM) and have no patentable weight. Data are data and functions or intended use on the data have no patentable weight unless the function or intended use of the data are carried out.

7. As for dep. claim 27 (part of 26 above), as indicated above, the phrase "...to predefine a plurality ofspecifier database" is not a positively recited method step but, rather, is mere intended use of the used workstation and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps. Furthermore, these limitation appear to be dealt with well known data management, i.e. accessible by a party such as the specifier, this is taught in BADE et al [0023] or [0207]. Moreover, the information/data on database "accessing" feature or parameter by any party such as specifier or supplier, is also taught by YON et al on col. 6, line 65 to col. 7, line 10.

8. As for dep. claim 28 (part of 26 above), which deal with well known practice for checking or validating operation of a color measuring (matching) equipment related in the transaction to ensure proper color communication between two entities, this is taught in col. 4, lines 26-65, col. 7, lines 15-67, Fig. 6.

Note on col. 8, lines 33-40, "understood by those skilled in the art that various changes may be made and equivalents maybe substituted for elements thereof without departing from the scope of the invention.... Many modifications...", these limitations as shown in the above dependent claims are well known non-essential inputs, changes and/or modifications to provide effective e-communication parameters of various parties

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involved in an e-transaction related to color features and would have been obvious to a skilled artisan to carry out these parameters.

As for independent system claim 25, which is basically the system to carry out the independent method claim 26 above, it's rejected over the steps of BADE et al /YON et al or vice versa to carry out the elements as shown in the rejection of claim 26 above.

As for dep. claims 3-4, 6-9 and 12-13 (part of 26 above), which appear to have similar limitations in dep. claims 21 and 27-28 of the independent method claims above, they are rejected for the same reason set forth in the rejection of dep. claim 23 above.

Response to Arguments

Applicant's arguments on 11/06/2008 with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection which are caused by applicant's amendment of the claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) NPL: The Article of "Pantone Announces ...for E-commerce", 11/30/1999 fairly teaches the claimed invention above and cited here for applicant's awareness of potential use in the future if needed to avoid multiple rejections.

2) NPL: The article "color World", April-Sept. 1999, fairly teaches the claimed invention above and cited here for applicant's awareness of potential use in the future if needed to avoid multiple rejections.

3) NPL: The article "TextileMaster", by X-Rite, April 2000, fairly teaches the claimed invention above and cited here for applicant's awareness of potential use in the future if needed to avoid multiple rejections.

No claims are allowed.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689